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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marigny Corporation

Serial No. 76294975

James E. Rosini and Andrea H. Scheidt of Kenyon & Kenyon
for Marigny Corporation.

Samuel E. Sharper, Jr., Trademark Examining Attorney, Law
Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Quinn and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Marigny Corporation has appealed from the final
refusal of the Trademark Examining Attorney to register the
mark WORLD CLASS GOURMET COFFEES and design, as shown
below, for coffee.¹ The words WORLD CLASS GOURMET COFFEES
have been disclaimed. Applicant has submitted the
following description of the mark:

¹ Application Serial No. 76294975, filed August 3, 2001, and
asserting first use and first use in commerce as early as August,
1995.

The mark consists of wording WORLD CLASS GOURMET COFFEES inside the bottom of two concentric circles and a design of an almost full coffee pot surrounded by two concentric circles with a drawing of continents on the coffee pot, a handle, and the top of the coffee pot intersecting the concentric circles.



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark WORLD CLASS COFFEES FOR WORLD CLASS PEOPLE, in the stylized form shown below, previously registered for coffee, tea and spices,²

² Registration No. 1593260, issued April 24, 1990; Section 8 and 15 affidavits accepted and acknowledged, respectively; renewed.

that, as used as applicant's goods, it is likely to cause confusion or mistake or to deceive.

World Class Coffees For World Class People

The appeal has been fully briefed. Applicant did not request an oral hearing.³

Preliminarily, we note that this application has had a tortured history. The Examining Attorney originally refused registration pursuant to Section 2(d), based on Registration No. 1486303 for WORLD CLASS for coffee. In a subsequent Office action, the Examining Attorney also cited as a bar Registration No. 1506184 for WORLD CLASSICS for, inter alia, coffee. Later, the Examining Attorney withdrew the citation of the WORLD CLASSICS registration, but made final the refusal of registration based on the WORLD CLASS registration. Still later, the Examining Attorney refused registration based on Registration No. 1593260 for WORLD

³ After applicant submitted its reply brief, the Examining Attorney issued, on March 3, 2006, an Office action stating that he has "reviewed the request for reconsideration and is not persuaded by applicant's arguments." No request for reconsideration was pending at the time, and it is unclear to what document the Examining Attorney was referring. In any event, an Office action discussing applicant's arguments was clearly inappropriate, as briefing had been completed. The Examining Attorney also objected in this paper to what he characterizes as untimely third-party registrations. The objection itself is mystifying, since applicant did not submit any third-party registrations with its brief or reply brief. The objection is overruled.

CLASS COFFEES FOR WORLD CLASS PEOPLE. The Examining Attorney ultimately issued a final refusal based on this registration, and withdrew the citation of the registration for WORLD CLASS. Interestingly, the registration for WORLD CLASS COFFEES FOR WORLD CLASS PEOPLE was brought to the Examining Attorney's attention by applicant, who had submitted it as a third-party registration to show the limited protection to be accorded the registration which was earlier cited as a bar.

We reverse the refusal of registration.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's identified goods, coffee, are legally identical to the coffee identified in the cited registration. The factor of the similarity of the goods, therefore, favors a finding of likelihood of confusion.

With respect to the factor of the channels of trade, applicant asserts that its goods and those of the registrant are sold in different channels. Applicant states that its parent company is one of the largest office coffee service companies in America, and that coffee marketed under applicant's mark is sold to commercial customers such as universities, multi-location restaurants and businesses, and hospitals. Its coffee cannot be purchased over the Internet, in retail stores, or by individual customers for personal use. Rather, applicant's sales force directly contacts the purchasing businesses and offices, and its coffees are sold by the case. Applicant also asserts that the registrant's goods are marketed to the general public through a retail store located in Stone Mountain, Georgia, and through an Internet website. Applicant states that the registrant's coffee can only be purchased in one-pound bags over the Internet or by telephone, facsimile or mail. Applicant apparently bases these contentions on its interpretation of the registrant's website materials, which include a page indicating that one

may print out an order form and mail or fax it, or may call a toll free number.

The problem with applicant's argument is that there are no limitations in either applicant's or the registrant's identification as to the channels of trade and classes of customers. The issue of likelihood of confusion between an applied-for and a registered mark must be determined on the basis of the goods as they are identified in the involved application and registration, not on what extrinsic evidence may show. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Accordingly, both applicant's and the registrant's goods must be deemed to travel in all channels of trade that are appropriate for such goods, and to be purchased by all potential buyers of coffee. *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The factor of the channels of trade favors a finding of likelihood of confusion.

Similarly, because the potential buyers of applicant's and the registrant's goods must be deemed to include the public at large, we must assume that the purchasers are not

sophisticated and, because coffee can be sold by the pound, it may be the subject of impulse purchases.

Despite these factors that favor a finding of likelihood of confusion, they are outweighed by the extremely limited scope of protection to which the registered mark is entitled and, in view of this, the differences in the marks. Applicant has submitted evidence to show that WORLD CLASS, the common element in the marks, is a laudatorily descriptive term. (COFFEES, the other term common to both marks, is, of course, generic and therefore has no source-indicating value.) The Merriam-Webster Dictionary defines "world-class" as "being of the highest caliber in the world <a *world-class* polo player>." The definitions in the American Heritage Dictionary of the English Language, 4th ed., © 2000, are "1. Ranking among the foremost in the world; of an international standard of excellence; of the highest order: *a world-class figure skater*. 2. Great, as in importance, concern, or notoriety." In fact, the Examining Attorney has recognized the descriptiveness of WORLD CLASS by requiring applicant to disclaim it (along with GOURMET COFFEE). The Examining Attorney stated that it describes applicant's goods, "i.e., applicant's coffee is world class in that it is the highest

caliber of coffee in the world and high quality coffee."

Office action mailed September 23, 2004.

Moreover, the Examining Attorney acknowledges that "the term 'world class coffee' is frequently used to describes [sic] high quality coffee." Id. The Examining Attorney has submitted excerpts from various third-party websites in which "world-class" is used to describe coffee. For example, the website for Fresh Coffee Now states, "Our Limited Edition coffees are world class coffees produced in very small quantities"; the website for Los Gatos Coffee Roasting Company offers "Eight world class coffees for the connoisseur"; and the website for Virtual World Cafe states that "Caribbean Coffee ... ha[s] been providing world class coffees to the most discriminating restaurants and high-end coffee houses." Applicant has provided additional instances of third-party use of the term "world class" in connection with coffee. These include a website for HARMONY BAY, whose products are described as WORLD CLASS "100% ARABICA GOURMET COFFEE"; and a two-page description of Jamaica Blue Mountain coffee by DREAM SHIP, which contains the paragraph, "A world class coffee is worth waiting for and our Jamaica Blue Mountain is Premier World Class Coffee that is 100% Certified by the Jamaica Coffee Industry Board."

Because of the laudatorily descriptive nature of WORLD CLASS, and the widespread use of this descriptive term in connection with coffee, consumers will not look to WORLD CLASS to identify the source of coffee, but will give greater importance to other elements of the marks. In other words, consumers will not assume that coffee emanates from a single source simply because of the inclusion of the term WORLD CLASS in the various marks.

With this in mind, we turn to a consideration of the marks. Applicant's mark consists of the descriptive and disclaimed wording WORLD CLASS GOURMET COFFEES, in the bottom half of a concentric circle which surrounds a large representation of a coffee pot, with the "pot" portion in the form of a globe. The Examining Attorney contends that the word portion of the mark is the dominant portion, and that the design is not sufficient to distinguish applicant's mark from the cited mark. The Examining Attorney is correct that, generally, when a mark consists of a word portion and a design portion, the word portion will be dominant. However, with respect to this mark, we disagree that the word portion is the dominant element. Because of the visual impression created by the prominent and unusual coffee pot design, coupled with the descriptiveness of the phrase WORLD CLASS GOURMET COFFEES,

consumers are likely to view the design as the source-identifying element of applicant's mark. As for the cited registration, WORLD CLASS COFFEES FOR WORLD CLASS PEOPLE, the mark would be perceived as a slogan. In this connection, we note that the Examining Attorney who examined the application which issued into the cited registration did not require a disclaimer of any words in the mark, despite the descriptiveness of WORLD CLASS and the genericness of COFFEES; obviously that Examining Attorney treated the mark as a unitary term, as would be the case for a slogan. Because of the unitary nature of the mark, consumers are not likely to pick out the individual term WORLD CLASS in WORLD CLASS COFFEES FOR WORLD CLASS PEOPLE, but will view the mark as a whole.

Thus, given the descriptive nature of WORLD CLASS, when the marks are considered in their entireties, the differences in appearance and pronunciation are significant. There are also differences in connotation: the globe design in applicant's mark emphasizes the geographic nature of the word WORLD, while the registrant's mark has no such meaning. These differences are sufficient, given the descriptive nature of WORLD CLASS, for us to conclude that the marks convey different commercial impressions. Moreover, given the weakness of

the registrant's mark, and the limited scope of protection to which it is entitled, we find that the marks are sufficiently different to avoid confusion.

In finding that there is no likelihood of confusion, we have given no weight to applicant's argument that there have been no instances of actual confusion, despite ten years of contemporaneous use. As applicant has stated, it currently sells its goods through limited trade channels using sales representatives who have direct personal contact with its customers. Thus, there may have been no opportunity for confusion to occur.

Decision: The refusal of registration is reversed.